

REMARKS

Claims 1-40 are all the claims pending in the application.

Claims 1-5, 7, 9-19, 21-25, 27, 29-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett et al. (U.S. Patent No. 6,282, 510) in view of Boys et al. (U.S. Patent No. 5,875,448) and further in view of Kwoh et al. (U.S. Patent No. 5,502,694).

Claims 6, 8, 20, 26, 28, and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett et al. in view of Boys et al., Kwoh et al., and further in view of Blum (U.S. Patent No. 4,663,678).

Claim 1 requires making changes to the recording medium data such that the changes are **automatically reflected in the computer audio data file on a real time basis.**

The Examiner admits that Bennet does not disclose the above feature. The Examiner admits that Boys does not teach the above feature either. In fact Boys teaches away from such automatic changes by editing a tape recorder and then storing a new version onto a computer file.

The Examiner appears to be using the teachings of Kwoh to overcome the above noted deficiency in the teachings of Bennet and Boys. However, Kwoh does not teach the above feature either. Just like Boys, Kwoh teaches away from such automatic changes because Kwoh supplements audio recording with instructions for the computer based apparatus. This is very different from making automatic changes in the computer data file on a real time basis.

In fact, in none of the references cited by the Examiner, the key limitation related to making changes to the recording medium data such that the changes are **automatically reflected in the computer audio data file on a real time basis** are suggested.

The Examiner appears to contend that Kwoh suggests a modification to the teachings of Bennett/Boys to arrive at the present invention. The Applicants respectfully submit that Kwoh suggests no such modification, because Kwoh teaches away from it. Kwoh includes instructions to supplement an audio recording for use with a computer based apparatus. Using such instructions, it is believed to be impossible to achieve the feature of making changes to the recording medium data such that the changes are **automatically reflected in the computer audio data file on a real time basis.**

Further, the Examiner generally asserts that a skilled artisan would have been motivated to combine the teachings of Bennett/Boys/Kwoh to make the current invention. The Federal Circuit has stated unequivocally that most if not all inventions arise from a combination of old elements. *In re Kotzab*, 99-1231 (CAFC June 2000), *citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Further, every element of a claimed invention may often be found in the prior art. *See id.*

As noted above, a significant element of the claimed invention relates to making changes to the recording medium data such that the changes are **automatically reflected in the computer audio data file on a real time basis** is missing in the cited references. Further, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *Id., citing, In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the

time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Kotzab*, 99-1231 (CAFC June 2000, citing *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

The court in *Kotzab* further accentuates that close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id. quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Federal Circuit appears to be clearly talking about the kind of situation as in the present case. A key aspect of the present invention is making changes to the recording medium data such that the changes are **automatically reflected in the computer audio data file on a real time basis**. The Examiner has relied on nothing more than the teaching of Kwoh for a motivation to modify the teachings of Bennet/Boys. But then Kwoh does not provide a motivation for any kind of automatic changes on a real-time basis.

Claim 1 should be allowed at least because a skilled artisan would not have been able to practice the present invention from the combined teachings of Bennet/Boys/Kwoh.

Claim 21 includes limitations analogous to the ones discussed above in relation to claim 1. Therefore the reasons for patentability of claim 1 discussed above are equally valid for claim 21.

Claims 2-20 and 22-40 are dependant on claims 1 and 21. Therefore they should be allowed at least by virtue of their dependency.

Amendment under 37 C.F.R. § 1.111
U.S. Application No.: 09/752,528

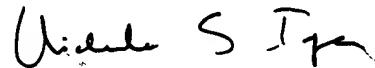
Attorney Docket No.: Q61414

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Chid S. Iyer
Registration No. 43,355

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: June 16, 2004